

REMARKS

Claims 1, 4-16, and 19-37 are currently pending in the present application. Claims 12-13, 16 and 19-31 have been amended to clarify the invention being claimed. Claims 2-3 and 17-18 have previously been canceled. Applicants request reconsideration and allowance of the application and Claims 1, 4-16, and 19-37 in light of the Amendments and Remarks contained herein.

I. Rejections of Claims

Claims 16-31 were rejected as directed to non-statutory matter under 35 U.S.C. §101. Claims 12-15 and 27-31 were rejected under 35 U.S.C. §112 as indefinite. Claims 1, 4, 8, 9, 11-13, 16, 19 23, 24 and 26-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2005/0054333 to Johnson (“Johnson”). Claims 5, 6, 14, 15, 20, 21, 29 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of U.S. Patent No. 5,764,731 to Yablon (“Yablon”). Claims 7, 22, and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson and Yablon in view of U.S. Patent No. 6,185,295 to Frederiksen et al. (“Frederiksen”). Claims 10 and 25 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson in further view of Frederiksen. Claims 32-34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of U.S. Publication No. 2004/0120493 to Creamer et al. (“Creamer”). Claims 35-36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson, Creamer and Yablon. Claim 37 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson, Creamer, Yablon and Frederiksen. These rejections are respectfully traversed.

II. Claims 16-31 Recite Statutory Subject Matter

Independent Claims 16 and 26 were rejected as directed to non-statutory subject matter. Specifically, the Office Action asserts that the computer readable medium may be directed to a propagation medium. Following *In re Beauregard*, 53 F.3d 1583, 35 U.S.P.Q. 2d 1383 (Fed. Cir. 1995), the U.S. Patent and Trademark Office declared that computer programs stored in a tangible medium, such as a computer readable storage medium, is patentable subject matter under 35 U.S.C. § 101. Additionally, according to the recent memorandum from the Director of

the U.S. Patent and Trademark Office dated January 26, 2010, a claim drawn to a computer readable medium may be amended to avoid a rejection under 35 U.S.C. § 101 by adding the limitation “non-transitory” to the claim. *Cf. Animals — Patentability*, 1077 Off. Gaz. Pat. Office 24. Accordingly, independent Claims 16 and 26 have been amended to recite a “non-transitory computer readable medium” Since a non-transitory computer readable medium is a tangible medium, Applicants respectfully submit that independent Claims 16 and 26, as well as the claims dependent therefrom, are directed to patentable subject matter under 35 U.S.C. § 101. Reconsideration and withdrawal of the 35 U.S.C. § 101 rejection of Claims 16-31 is respectfully requested.

III. Claims 12-15 and 27-31 Recite Patentable Subject Matter Under 35 U.S.C. §112

The Office Action asserts that the term “the SMS text message” has no antecedent basis in Claims 12-15 and Claims 27-31. Applicants have amended base Claims 12-13 and 27-28 so that the term “the SMS text message” now recites “a SMS text message,” providing proper antecedent basis for Claims 12-15 and Claims 27-31 of the term “the SMS text message.” As such, it is submitted that Claims 12-15 and 27-31 are definite under 35 U.S.C. §112 and reconsideration and withdrawal of the rejection under 35 U.S.C. §112 of these claims is respectfully solicited.

IV. All Claims Patentably Define Over the Cited Art

Embodiments of the present invention are directed to automatically storing on a mobile device (e.g., a mobile phone) a phone number that was solicited from an information service (e.g., “411”). The user of the mobile device contacts the information service by dialing 411 (or the like) and either a live operator or automated answering system guides the user through the process of obtaining the phone number sought by the user. The user is prompted as to the method of delivery of the phone number to the user’s mobile device (e.g., SMS text message, audible delivery, etc.). In one embodiment, the requested phone number is audibly provided to the mobile phone user by the information service. The mobile phone detects the audible recitation of the phone number and can store the phone number within the mobile device. In another embodiment, the information service can provide the requested phone number in a SMS

text message addressed to the mobile device. In yet another embodiment, the mobile device can determine the phone number based solely on the connection established with the requested phone number. Either way, the user of the mobile device can selectively obtain and store the requested phone number as opposed to only “hearing” the requested phone number one time. Thus, embodiments of the present invention are specifically targeted to information service directories that perform look-up assistance for phone numbers on an as needed basis.

The primary cited reference, Johnson, is directed to placing a telephone number into a wireless device by allowing the user to receive a data message containing the requested phone number from a directory assistance service.

A. Independent Claims 1, 11, 16 and 26

Johnson does not teach or suggest each of the recitations of independent Claims 1, 11, 16, and 26. For example, there is no teaching or suggestion in the cited art of record of: “prompting a user of the mobile phone for a method of delivery of the requested phone number by presenting a plurality of methods of delivery, wherein each method of delivery comprises a different channel for transmitting the requested phone number to the mobile number,” as recited in independent Claims 1, 11, 16, and 26. In Johnson, the user automatically receives a “data message” containing the phone number in response to the user stating that the user wants to receive the phone number; however, the user of Johnson is not presented with any option as to the specific method of delivery and there is no transmission of the user’s selected method of delivery.

In the Office Action, the Office correctly acknowledges that Johnson does not teach or suggest the above-identified recitations of independent Claims 1, 11, 16, or 26. However, the Office makes a conclusory assertion that it would have been obvious to one skilled in the art to prompt for a method of delivery of the requested phone number and that such limitation is a mere design choice. To the extent the Office Action is attempting to take “official notice” of facts not in the record or is asserting that the limitations recited in independent Claims 1, 11, 16, or 26 are “common knowledge,” Applicants respectfully traverse. Applicants respectfully submit that it would have not been generally recognized as being within the level of ordinary skill in the art at the time the present invention was conceived to prompt a user of the mobile phone for a method of delivery of the requested phone number by presenting a plurality of methods of delivery, wherein each method of delivery comprises a different channel for

transmitting the requested phone number to the mobile number. In accordance with MPEP §2144.03(C), Applicants demand that the Examiner produce authority for the statement/assertion that the following limitations are “common knowledge”, as Applicants submit that such features are not common knowledge or well-known in the art or a mere design choice.

Moreover, mere conclusory statements, such as contained in the Office Action (e.g., “it would have been obvious to one of ordinary skill in the art to try either option” and “it would have been a design choice to choose one of the two aforementioned possibilities” (page 6, first paragraph)), does not provide the articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *See KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) and § MPEP 2142. As such, Applicants submit that the Examiner has not met the initial burden of factually supporting any *prima facie* conclusion of obviousness and, thus, Applicants are under no obligation to submit evidence of nonobviousness. *See* § MPEP 2142.

Further, since there is no disclosure in the cited references of record (as acknowledged by the Office Action) of “prompting a user of the mobile phone for a method of delivery of the requested phone number,” there is also no disclosure of “transmitting a selection of a selected method of delivery for the requested number by the user,” “receiving the requested phone number at the mobile phone from the information service in response to the information service receiving a user selection of the method of delivery,” and “detecting the requested phone number returned from the information service in accordance with the selection made by the user,” as recited in Claims 1, 11, 16, and 26.

Additionally, independent Claim 11 recites additional features not taught or suggested by Johnson. Claim 11 recites “determining, solely by the mobile device, the requested phone number returned from the information service in accordance with the selection made by the user.” First, Applicants note that the limitation of “solely by the mobile phone” was ignored by the Office Action which is improper. Second, the mobile phone of Johnson does not determine the requested phone number, but only allows for receipt of a data message containing the phone number.

In light of the above, it is respectfully submitted that independent Claims 1, 11, 16, and 26, and the claims depending therefrom, are patentably distinguishable over Johnson.

Reconsideration and withdrawal of the rejection under Section 103 of Claims 1, 11, 16, and 26, and the claims depending therefrom, is respectfully requested.

B. Independent Claim 32

With regard to independent Claim 32, it is submitted that Claim 32 patentably defines over Johnson as discussed below. Claim 32 recites:

32. A method of storing a phone number within a mobile phone, said phone number received from an information service, the method comprising:

 placing a call to an information service to obtain a requested phone number;

 having the information service automatically connect the mobile phone to the requested phone number;

 detecting the requested phone number that the information service connected the mobile phone to based on a connection established between the mobile phone and the requested phone number in response to the mobile phone being connected to the requested phone number; and

 storing the detected requested phone number that the information service connected the mobile phone to.

Neither Johnson nor Creamer, singly or in combination, teach or suggest each of the above recitations of Claim 32. For example, neither Johnson nor Creamer teach or suggest “detecting the requested phone number that the information service connected the mobile phone to *based on a connection established between the mobile phone and the requested phone number in response to the mobile phone being connected to the requested phone number.*” As explained above, Johnson is directed to sending a data message to the user’s mobile phone only. Additionally Creamer is directed to “presenting the name of the person called to a caller” if the user has been “transferred to an unknown phone number.” See paragraph [0026] of Creamer. There is no disclosure or suggestion in any of the cited references, either singly or in combination, of detecting the phone number based on the connection between the mobile phone and the requested phone number after the mobile phone has been connected with the requested phone number. Accordingly, Applicants submit that independent Claim 32, and the claims depending therefrom, patentably defines over both Johnson and Creamer, whether considered singly or in combination. As such, Applicants respectfully request reconsideration and

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withdrawal of the 35 U.S.C. § 103 rejection of independent Claim 32, as well as the claims dependent therefrom.

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Conclusion

In view of the claims and the remarks presented above, it is respectfully submitted that all of the present claims of the application are in condition for immediate allowance. It is therefore respectfully requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicant's undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 13-4365.

Respectfully submitted,

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